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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,265

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Esben Strobec

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EXAMINER

REDDY, SATHAVARAM I

ART UNIT

PAPER NUMBER

1785

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,265	<b>Applicant(s)</b> STROBECH ET AL.	
	<b>Examiner</b> SATHAVARAM I. REDDY	<b>Art Unit</b> 1785	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-28, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 and 18-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Examiner's Comments***

**1. In regard to the response filed on 8/19/2011, the Examiner is withdrawing finality and is presenting a new non-final rejection. Claims 1 and 32 are amended, claims 17 and 29-31 are cancelled, claims 14-16 and 18-28 are withdrawn and claims 1-16, 18-28 and 32-33 are pending.**

### ***Claim Rejections - 35 USC § 103***

**2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 1-3, 5-13 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kavanagh et al (US 6,206,864).**

Regarding claim 1, Kavanagh et al (US 6,206,864) discloses an absorbing element comprising an elastomeric matrix with hydrocolloids having adhesive properties (col. 3, lines 44-59; col.3, lines 63-66) wherein the first facade of the absorbing element comprises grottos (Fig. 2; col. 4, lines 36-38).

Kavanagh et al (US 6,206,864) does not appear to disclose the absorbing element comprising each grotto having a minimum diameter of 5  $\mu\text{m}$  and the average diameter of the plurality of grottos being less than 300  $\mu\text{m}$ .

However, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the minimum diameter of each grotto to 5  $\mu\text{m}$  and the average diameter of the plurality of grottos to be less than 300  $\mu\text{m}$  in order to provide more effective adhesive attachment in resisting pulling forces in use and reducing area of adhesive attachment in the lower region in order to avoid pinching and other patient discomforts ((col. 1, lines 54-60) of Kavanagh et al (US 6,206,864)) for the intended application, and this is supported by MPEP 2144.05(II)(A).

“[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be prima facie obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%).

Regarding claims 2 and 3, the grottos being obtained by heat treatment or heating of the absorbing element is a process limitation in a product claim.

“Even though the product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-

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process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (In re Thorpe, 227 USPQ 964,966) Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product (In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP 2113).

Regarding claim 5, Kavanagh et al (US 6,206,864) discloses the absorbing element comprising the first façade being adapted for releasable adhesion (col. 3, lines 44-59).

The first façade being adapted for releasable adhesion is also an intended use limitation.

The limitation(s) "adapted for releasable adhesion" is (an) intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned. Note that "in apparatus, article, and composition claims, intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. **If the prior art structure is capable of performing the intended use, then it meets the claim.** In a

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claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02.

Regarding claim 6, Kavanagh et al (US 6,206,864) discloses the absorbing element comprising the hydrocolloids being guar gum (col. 3, lines 59-63).

Regarding claim 7, Kavanagh et al (US 6,206,864) discloses the absorbing element comprising tacky elastomeric matrix (it is well established that the elastomeric matrix is self-adhesive) (col. 3, lines 44-59).

Regarding claim 8, Kavanagh et al (US 6,206,864) discloses the absorbing element comprising the elastomeric matrix being a rubbery elastomeric base (col. 3, lines 44-59; col. 3, lines 63-66). The elastomeric matrix is rubbery in that it is deformable.

Regarding claim 9, Kavanagh et al (US 6,206,864) discloses the absorbing element comprising the elastomeric matrix not flowing at room temperature (col. 3, lines 44-59; col. 3, lines 63-66).

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Regarding claim 10, the grottos being obtained by heat treatment of the first façade of the absorbing element with electromagnetic radiation with a wavelength of more than 400 nm is a process limitation in a product claim.

Regarding claim 11, the grottos being obtained by heat treatment comprising irradiation of the first faced with an infrared laser is a process limitation in a product claim.

Regarding claim 12, Kavanagh et al (US 6,206,864) does not appear to disclose the absorbing element comprising the average diameter of the grottos being less than 200 µm.

However, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the minimum diameter of each grotto to 5 µm and the average diameter of the plurality of grottos to be less than 300 µm in order to provide more effective adhesive attachment in resisting pulling forces in use and reducing area of adhesive attachment in the lower region in order to avoid pinching and other patient discomforts ((col. 1, lines 54-60) of Kavanagh et al (US 6,206,864)) for the intended application, and this is supported by MPEP 2144.05(II)(A).

“[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be prima facie obvious over a reference process which differed from the claims only in that

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the reference process was performed at a temperature of 100°C and an acid concentration of 10%).

Regarding claim 13, Kavanagh et al (US 6,206,864) discloses the absorbing element being part of a medical device such as a stomal device (col. 1, lines 7-13).

Regarding claim 32, the grottos being configured to reduce peel adhesion by decreasing an adhesive surface area in contact with the skin is an intended use limitation as stated above.

Regarding claim 33, the grottos having a different surface property as compared with the remainder of the first façade where the different surface property is being produced by heat treatment is a process limitation in a product claim as stated above.

**4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kavanagh et al (US 6,206,864) in view of Pawelchak et al (US 4,393,080).**

Kavanagh et al (US 6,206,864) is relied upon as described above.

Regarding claim 4, Kavanagh et al (US 6,206,864) does not appear to explicitly disclose the absorbing element comprising a pressure sensitive adhesive.



However, Pawelchak et al (US 4,393,080) discloses the absorbing element comprising a pressure sensitive adhesive (col. 2, lines 46-57).

Kavanagh et al (US 6,206,864) and Pawelchak et al (US 4,393,080) are analogous art because they are from the same field of absorbing elements.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Kavanagh et al (US 6,206,864) and Pawelchak et al (US 4,393,080) before him or her, to modify the absorbing element of Kavanagh et al (US 6,206,864) to include the pressure sensitive adhesive of Pawelchak et al (US 4,393,080) in that having a pressure sensitive adhesive provides dry adhesion and hold the entire composition together ((col. 2, lines 58-60) of Pawelchak et al (US 4,393,080)).

### ***Response to Arguments***

**5. Applicant's arguments, see 11-16, filed 8/19/2011, with respect to the U.S.C 103(a) rejections of claims 1-5, 7-13 and 31-33 over Chen (US 3,941,133) in view of Lipman (US 6,326,421) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S.C 103(a) rejections of claims 1-4, 7-13 and 32-33 over Kavanagh et al (US 6,206,864) and Pawelchak et al (US 4,393,080).**

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**6. Applicant's arguments with respect to claims 1-4, 7-13 and 32-33 have been considered but are moot in view of the new ground(s) of rejection.**

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SATHAVARAM I. REDDY whose telephone number is (571)270-7061. The examiner can normally be reached on 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on (571) 272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Betelhem Shewareged/  
Primary Examiner, Art Unit 1785

/SIR/